

REMARKS

The claimed invention is directed to a stretched film of a void-containing thermoplastic resin. According to a feature of the invention, the stretched film of a void containing thermoplastic resin has a surface charge potential, after discharging of the film, of -10 to 10 kV. This maintains an attractive force between the sheets of the film of 50 grams or less (paragraph [0022]), which simplified handling of the sheets during feeding and removal from offset presses.

Claims 1, 3-8 and 10-11 were again rejected under 35 U.S.C. § 102 or under 35 U.S.C. § 103 as being anticipated or rendered obvious by PCT '601 as represented by the U.S. patent to Nishizawa et al.

Applicants had previously pointed out that Nishizawa et al does not explicitly teach or suggest a stretched film of a void containing thermoplastic resin has a surface charge potential, after discharging of the film, of -10 to 10 kV, and that there is no evidence that Nishizawa et al inherently teaches this feature. Indeed, the specification provides evidence (Examples 1 and 2, and Comparative Examples 1 and 2 described in paragraphs [0067]-[0069]) that a charge potential of from -10 to 10 kV cannot be achieved without providing a direct current voltage overlaid on a high voltage of high frequency. There is no evidence of such a direct current voltage overlaid on a high voltage of high frequency in Nishizawa et al.

In response to this explanation, the outstanding Office Action recognizes that "it is true that the films of the prior art have not been subject to a direct current voltage overlaid on a high voltage of high frequency." Nonetheless, the Office Action states that "such does not necessarily mean that the films of the prior art do not attain the surface charge within the claimed potential when the high voltage is applied to the claims." It is respectfully submitted that this assertion is legally insufficient to support a rejection based on anticipation or obviousness due to inherency, for a number of reasons.

First, a rejection based on inherency requires that the Examiner must “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1463 (Bd. Pat. App. & Inter. 1990); MPEP § 2112(IV). No such basis has here been set forth. The assertion of such evidence in the Office Action is the statement (p. 4) that:

[T]he films of the prior art and the present invention serve for the same purposes ... nothing in the prior art teach or suggest that the application of the direct current voltage overlaid on a high voltage of high frequency to the films would have destroyed the function of the films. Therefore, it is the examiner’s position that the claimed surface charge potential would be necessarily present when a direct current voltage is applied to the film.

This statement evidently purports that since Nishizawa et al and the invention both “serve for the same purposes,” Nishizawa et al must have the same surface charge as is claimed. However this reasoning is not “a basis ... to reasonably support the determination that” the claimed surface charge is necessarily present in Nishizawa et al since there is no evidence that the claimed surface charge is necessary for an in-mold forming label. Indeed, the present specification makes clear that this surface charge merely simplifies handling of the sheets during feeding and removal from offset presses. Thus any similarity in purpose is not evidence of the inherency of the claimed surface charge in Nishizawa et al.

Applicants also note that the Office Action states that “the claimed charge potential is not found to be limiting in a patentable sense with respect to the article claimed” (p. 3, penultimate sentence). Therefore, “it is not seen that the films of the prior art could not have met the claimed surface charge potential when they are subjected to a direct current voltage overlaid on a high voltage or high frequency” (p. 4). If this statement is intended to point to evidence of inherency for the sheet of Nishizawa et al, it is respectfully submitted that it fails because there is no evidence that the films of Nishizawa et al are in fact subjected to a direct

current voltage overlaid on a high voltage or high frequency, nor is there evidence that this would have been obvious to one skilled in the art. If it was instead intended to assert that the claimed surface charge is not a structural feature of the claim, it must also fail because a charged surface is *structurally different* from an uncharged surface, e.g., one has fewer electrons than the other. See, e.g., the decision in *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999) which held that a programmed general purpose computer is structurally difference from the unprogrammed computer; note that the two are identical except for states of charge in their memories but are nonetheless recognized as structurally different.

In any case, the present specification provides evidence that a similar composition and void ratio is insufficient to inherently provide the claimed charge potential, without additionally providing a direct current voltage overlaid on a high voltage of high frequency, since Example 1 and comparative Example 1 are identical (paragraph [0067]) except for providing a direct current voltage overlaid on a high voltage of high frequency. Thus the present specification provides evidence that a similar composition and void ratio is insufficient to inherently provide the claimed charge potential, without additionally providing a direct current voltage overlaid on a high voltage of high frequency, since Example 1 and comparative Example 1 are *identical* (paragraph [0067]) except for providing a direct current voltage overlaid on a high voltage of high frequency.

Finally, Applicants are presently submitting a declaration under 37 C.F.R. § 1.132 of Takatoshi Nishizawa, the first named inventor of both the present application and the Nishizawa et al reference (unsigned copy being filed with the response, signed copy to follow), setting forth additional evidence that the film of Nishizawa et al (as well as those of Lin and EP '544) does not exhibit the claimed surface charge potential of -10 to 10 kV. As explained in section (1) of the Nishizawa declaration, samples were prepared according to

Example 1 of Nishizawa et al, Example 1 of EP '544 and Example 1 of Lin. Section (2) of the declaration shows that in each case the surface charge potential was substantially higher than -10 to 10 kV. Thus Nishizawa et al does not inherently meet the claimed limitations and does not anticipate the claims.

Nor would the claimed thermoplastic resin having a surface charge potential, after discharging of the film, of -10 to 10 kV be obvious from Nishizawa et al. There is no description in Nishizawa et al of a desire to limit the surface charge potential and so no motivation in the art for providing the claimed surface charge potential. Additionally, any *prima facie* case of obviousness is rebutted by the showing of unexpected improved results in the Examples including Comparative Examples 1 and 2, and in the examples of the Nishizawa declaration. M.P.E.P. § 2144.05(III).

Claims 1 and 3-11 were also rejected under 35 U.S.C. § 102 or under 35 U.S.C. § 103 as being anticipated or rendered obvious by Lin. However, the above remarks and test results also apply to this reference. Lin is directed to a process of forming three layer coextruded biaxial oriented polypropylene synthetic paper, in which the synthetic paper is subjected to a corona discharge to improve the printability of the surface of the film. Again, however, there is no disclosure in the reference of applying a direct current voltage overlaid on a high voltage of high frequency in order to dissipate the resulting surface charge, and so the presently claimed surface charge is not inherent therein. This, combined with the evidence of criticality results set forth in the specification, clearly points to the unobviousness of the claims over Lin.

Claims 1, 3-8 and 10-11 were also rejected under 35 U.S.C. § 102 or under 35 U.S.C. § 103 as being anticipated or rendered obvious by EP '544. However, here again, there is no teaching of applying a direct current voltage overlaid on a high voltage of high frequency in order to dissipate the resulting surface charge, and so the presently claimed surface charge is

not inherent therein. This, combined with the evidence of criticality results set forth in the specification and test results, clearly points to the unobviousness of the claims over this reference.

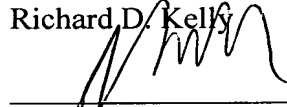
Concerning paragraphs 9-10 of the Office Action, the further reference to Burns et al was cited to teach a feature of several of the dependent claims, and provides no teaching for overcoming the shortcomings of the primary references with respect to Claim 1. Applicants therefore respectfully submit that the claims define over any combination of the above references.

Applicants believe that the present application is in a condition for allowance and respectfully solicit an early Notice of Allowability.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard D. Kelly



Robert T. Pous
Registration No. 29,099
Attorney of Record